

REMARKS

Status of the Application

In the Advisory action of August 15, 2006, the amended claims previously submitted in response to the final rejection of April 28, 2006 were not entered for the reason that the recitation "the entire transparent coating...remains on the substrate" presented a new issue. The arguments put forth in that Response also were not considered because they relied on the claim amendments that were not entered, making those arguments moot. This Response therefore puts forth the same claim amendments and arguments that were not entered in the August 15, 2006 Advisory Action.

Status of the Claims

In the Office Action of April 28, 2006, Claims 1 and 4-12 were pending. All claims were rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over a variety of combinations of references. Claims 1, 4, 8, 9, 11, 12 were rejected as being obvious and unpatentable over Doi (JP 01-202492) in view of Yamane (JP 63-128987 – hereinafter "Yamane JP") and Wagner (U.S. Patent No. 6,486,903) and over Yamane et al (U.S. Patent No. 5,320,885 – hereinafter "Yamane '885") in view of Doi and Wagner. Claim 5 was rejected as being obvious and unpatentable over Doi in view of Yamane JP, Wagner, and Oshima (U.S. Patent No. 5,427,997) and over Yamane '885 in view of Doi, Wagner, and Oshima. Claims 6 and 7 were rejected as being obvious and unpatentable over Doi in view of Yamane JP, Wagner, Oshima, and Shvartsman (U.S. Patent No. 6,245,382) and over Yamane '885 in view of Doi, Wagner, Oshima, and Shvartsman. Claim 10 was rejected as being obvious and unpatentable over Doi in view of Yamane JP, Wagner, and Bruns (U.S. Patent No. 4,737,322) and over Yamane '885 in view of Doi, Wagner and Bruns.

Claims 1 and 4-8 have been canceled. Claim 9 has been amended to clarify that the entire transparent coating remains on the substrate after removal of the backing foil, which is not disclosed by any of the image transfer method references relied upon in the rejections of this claim. Support for this amendment can be found in the fact that nowhere in the application is it suggested that only some portion of the transparent coating is to remain on the substrate and, further, in the inferences

that can drawn from the statements regarding the transparent coating at 11:1-3 and 12:4-7 of the application. Claim 9 has further been amended in minor regards to remove an ambiguity in the claim language (by changing “and of a backing foil” to “and providing a backing foil” in step a), to correct punctuation, and to make the claim consistent with the absence of Claim 1 (by changing “a’)” to “a)”, etc.). Claims 10-12 have been amended in very minor regards to reflect the changes made to Claim 9, on which these claims are dependent. The subject matter of canceled Claims 4-7 has been incorporated into new Claims 13-16, which are dependent upon Claim 9 as opposed to Claim 1. Support for these new claims can be found in canceled Claims 4-7. Thus, Claims 9-16 are pending. No new matter was added.

Claim Rejections – 35 USC § 103

Claim 9

Claim 9, the sole independent claim pending, was rejected as being obvious and unpatentable over Doi (JP 01-202492) in view of Yamane JP (JP 63-128987) and Wagner (U.S. Patent No. 6,486,903). Applicants respectfully submit that such a combination of references fails to render the current invention obvious and request that the rejection be withdrawn and that this claim, and all claims dependent upon it, be allowed.

As an initial matter, Claim 9, upon which all other pending claims are dependent, has been amended to clarify that the entire transparent coating remains on the substrate after removal of the backing foil. With this clarification the combined references fail to show certain features of the applicant’s invention, namely that the entire coating layer covering the image remains on the substrate in the current invention and does not do so in either of the cited references that relate to image transfer, Yamane JP or Wagner. In Yamane JP only the ink of the image is transferred with no portion of any coating layer remaining on the substrate after transfer of the image (Yamane JP English Language Abstract; see also discussion in Yamane ‘885 patent at col. 1 line 44 - col. 2 line 24), while in Wagner the only portions of the coating layer remaining on the substrate after transfer are those portions directly in contact with the image; the portions of the layer adjacent to the image are not transferred to the substrate (Wagner patent col. 4 lines 34-39 and Figs. 1-6). This novel feature of the current invention results in certain unexpected

advantages over the cited prior art references. Having the entire transparent coating layer remain to cover the image results in protection of the image, thereby enhancing the image's durability (1:31-2:2). This is not true in the prior art references cited. Thus, even if the cited references are combined, they fail to teach the current invention and therefore do not support a finding of obviousness. Applicants therefore submit that the obviousness rejections to Claim 9 and all of its dependent claims have been obviated by the amendment to Claim 9 and Applicants respectfully request that the rejections be withdrawn and all claims allowed.

Examiner contends that it would be obvious to one skilled in the art to combine Doi, which requires a thin metal film layer, with Yamane JP, which transfers an image to a substrate without the use of a thin metal film layer, to arrive at the current invention. However, Applicants submit that, for several reasons, this is not so.

As an initial matter, both Yamane JP and Doi fail to either teach or suggest that their combination would be either possible or desirable. MPEP § 2143.01 Part III, citing *In re Mills* (916 F.2d 680 (Fed. Cir. 1990)), states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As there is no such suggestion in the cited references here, Applicants contend that these two references should not be combined to arrive at a finding of obviousness.

Further, Examiner states that elimination of the thin metal layer from Doi, as in Yamane JP, "would have been obvious to one of ordinary skill in the art wishing to simplify the structure of the transfer sheet of Doi" (April 28, 2006 Office Action, 9:1-3). However, Applicants contend that it would never be obvious to simplify the structure of Doi by eliminating the thin metal layer as the entire purpose of the Doi invention is to transfer just that metal layer (Doi English Language Translation (ELT) 4:4-10, 4:16-24). The Doi specification requires "at least a thin metal film layer" (Doi ELT 4:20). This requirement for "at least a thin metal film layer" is also stated in the sole dependent claim in that application, Claim 1 (Doi ELT 2:4-8). Doi's absolute requirement for a thin metal film layer is due to the fact that the Doi invention is directed toward an improved method of transferring a metal layer to a substrate to impart upon that substrate "a metal tone appearance" (Doi ELT 11:23-24). The Doi invention eliminates a drawback to prior art transfer films containing a thin metal

layer (Doi ELT 4:7-10, 5:3-6), namely that “the metal luster of the thin metal film layer becomes dull” during the transfer process (Doi ELT 4:4-5). Because the purpose of the Doi invention is to correct deficiencies in prior art methods of imparting a metal tone appearance upon a substrate, elimination of the thin metal film layer of the Doi invention could not be and is not either taught or suggested by Doi. In fact, because Doi is designed to transfer a thin metal layer to a substrate, it actually teaches away from elimination of that layer. Because of all this, it is irrelevant which references are combined with Doi; it would not be obvious to eliminate the thin metal film layer from the Doi invention in view of any references, including Yamane. MPEP § 2143.01 Part V, citing *In re Gordon* (733 F.2d 900 (Fed. Cir. 1984)), states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Here, eliminating the thin metal layer would clearly render the Doi invention unsatisfactory for its intended purpose of providing an improved method for transferring thin metal layers and imparting metal tone appearances upon substrates, so there is no suggestion or motivation to make such a modification here. Further, MPEP § 2143.01 Part VI, citing *In re Ratti* (270 F.2d 810 (CCPA 1959)), states “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” Again, the proposed modification of Doi, elimination of the thin metal layer, would change the principle operation of the Doi invention by removing the very layer that would impart the desired metal tone appearance, so the teachings of these references are insufficient for a finding of obviousness. In contrast to Doi, the current invention absolutely requires that no such thin metal layer is present. Claim 9 of the current invention states that the process consists of the listed steps, those steps not including the presence of any thin metal layer. As “consists of” creates an exhaustive list, this claim language precludes the presence of any such layer. Further, in the previous Response to Office Action, dated March 16, 2006, the use of any such metal layer was specifically disclaimed (page 5, paragraph 5). Thus, the current invention is in no way an obvious adaptation of Doi in view of Yamane JP, or any other reference for that matter, since it would not be obvious to eliminate the thin metal film layer from Doi and since the current invention precludes the presence of

any such layer. Applicants therefore submit that the cited references in combination fail to render the current invention obvious.

Examiner also contends that the current invention is rendered obvious by Doi and Yamane JP in view of Wagner in that Wagner teaches the use of inkjet printing as a means of delivering the image to the transfer sheet. While it is unquestionable that Wagner does so teach, for the same reasons given for the Doi /Yamane JP combination above, this reference fails to make the current invention obvious. First, Wagner and Doi both fail to teach or suggest that they could be used in combination, just as Yamane JP and Doi so fail. Second, for the reasons stated above, the Wagner reference, even in combination with Yamane JP, fails to teach or suggest the elimination of the thin metal layer from Doi. Doi relates to a method of transferring a thin metal film layer to a substrate in order to impart a metal tone appearance upon that substrate and there is nothing in Wagner, just as there is nothing in Yamane JP, that would suggest that such a layer could be eliminated. In fact, as discussed above, elimination of the thin metal layer would make the Doi invention inoperable, leading to a conclusion that no combination of references would make it obvious to eliminate that thin metal layer. For these reasons, Applicants submit that Doi, Yamane JP, and Wagner should not be combined to arrive at a finding of obviousness, and that they fail to render the current invention obvious even if combined.

Claim 9 was also rejected as being obvious and unpatentable over Yamane '885 (U.S. Patent No. 5,320,885) in view of Doi (JP 01-202492) and Wagner (U.S. Patent No. 6,486,903). Applicants respectfully submit that such a combination of references fails to render the current invention obvious and request that the rejection be withdrawn and that this claim, and all claims dependent upon it, be allowed.

Yamane '885 discloses a transfer sheet lacking the curable coating composition of the current invention, instead containing a surface treating agent (Yamane '885 patent col. 4 lines 4-16 and 40-46). Examiner contends that it would have been obvious to one skilled in the art to use a curable coating composition, as is taught by Doi, as an alternative to Yamane '885's surface treating agent (April 28, 2006 Office Action 5:16-6:2). As Yamane '885 also lacks the inkjet printing method of image production of the current invention, Examiner further contends that it would have obvious to one of ordinary skill in the art to further combine Yamane '885 and

Doi with Wagner, which teaches the use of inkjet printing to generate the image (April 28, 2006 Office Action 6:3-12).

As an initial matter, as is stated above, the cited references fail to teach or suggest the given combination; nowhere in any of the cited references is it even suggested that such a combination would be either possible or desirable. MPEP § 2143.01 Part III, citing *In re Mills* (916 F.2d 680 (Fed. Cir. 1990)), states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” As there is no such suggestion in the cited references here, Applicants contend that these references should not be combined to arrive at a finding of obviousness.

However, even when combined, the cited references fail to render the current invention obvious. Yamane ‘885 utilizes a surface treating agent upon which the image is printed (Yamane ‘885 patent col. 4 lines 4-16 and 40-46). For the invention to operate, this surface treating agent must have properties such that only a portion of the surface treating agent, the portion “exactly below the printed ink image,” is retransferred to the substrate (Yamane ‘885 patent col. 3 lines 34-41), which essentially requires breakage of the surface treating agent at the ink boundaries during the transfer process (Yamane ‘885 patent Figs. 1-4). This requires the surface treating agent to have a very specific tensile strength, namely in the range of 1-100 Kg/cm² (Yamane ‘885 patent col. 6 line 63 – col.7 line 6). Doi, on the other hand, requires the use of a curable coating composition (Doi ELT 4:12-20, 6:15-20). In contrast to Yamane ‘885, it is implied in the Doi disclosure that the Doi coating composition must be sufficiently strong so that the coating composition does not break during the transfer process for the invention to be operable. As such, there is no maximum tensile strength requirement in Doi as is found in Yamane ‘885. Because of this fundamental difference between the Yamane ‘885 and Doi inventions, it would not be obvious for one skilled in the art to replace the Yamane ‘885 surface treating agent with the Doi curable coating composition as this would likely result in the Yamane ‘885 invention becoming inoperable. MPEP § 2143.01 Part V, citing *In re Gordon* (733 F.2d 900 (Fed. Cir. 1984)), states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification.” Here, replacing the highly specific surface treating agent layer of Yamane ‘885 with the curable coating composition of Doi would likely render Yamane ‘885 unsatisfactory for its intended purpose of printing ink images in the manner specified by the patent, so there is no suggestion or motivation to make such a modification here. Therefore, Applicants contend the current invention is not obvious in view of Yamane ‘885 in combination with Doi.

Examiner further states that the addition of Wagner to the Yamane ‘885 and Doi references further teaches the use of inkjet printing as the means of generating the image. However, as was stated above, Yamane ‘885 and Doi fail to make obvious any image transfer in the current invention, regardless of how the image itself is generated. Thus, Wagner fails to add any further obviousness to the other cited references.

Further, since Yamane ‘885 in combination with Doi and Wagner fails to teach certain vital aspects of the current invention, namely that the entire transparent coating remains on the substrate after removal of the backing foil, these references do not render the current invention obvious. In both Yamane ‘885 and Wagner the only portions of the layer on which the image is printed that remain on the substrate are those portions directly in contact with the image; the portions of the layer adjacent to those directly in contact with the image are not transferred to the substrate (Yamane ‘885 patent col. 3 lines 34-41 and Figs. 1-4; Wagner patent col. 4 lines 34-39 and Figs. 1-6). In contrast, amended Claim 9 clearly states that the entire coating layer is to remain on the substrate after backing foil removal, even in areas where there is no underlying image. This novel feature of the current invention results in certain unexpected advantages over the cited prior art references. Having the entire transparent coating layer remain to cover the image results in protection of the image, thereby enhancing the image’s durability (1:31-2:2). This is not so in the prior art references cited. Thus, Applicants contend that any obviousness rejections to Claim 9 have also been obviated by the current amendment to that claim.

For the foregoing reasons Applicants submit that the cited references fail to render the current invention obvious and therefore respectfully request that the rejections be withdrawn and the claim allowed. As this is the sole independent claim in the application, Applicants further request that all rejections be withdrawn and all claims allowed.

Claims 4, 11, and 12

Claim 4, whose subject matter has been incorporated into new Claim 13, as well as Claims 11, and 12 were rejected as being obvious and unpatentable over Doi (JP 01-202492) in view of Yamane JP (JP 63-128987) and Wagner (U.S. Patent No. 6,486,903) and over Yamane '885 (U.S. Patent No. 5,320,885) in view of Doi (JP 01-202492) and Wagner (U.S. Patent No. 6,486,903). Applicants respectfully submit that such combinations of references fail to render the current invention obvious and request that these rejections be withdrawn and the claims allowed.

In the current invention, a heat or radiation curable resin is coated onto a backing foil and is either left uncured or is partially cured prior to application of the image to the coating (2:5-13). After application of the image-bearing coating to the substrate, the resin is then completely cured by heat or radiation (13:21-14:4; 14:29-32). Doi discloses the use of a resin curable by the use of either UV or electron beam radiation (Doi ELT 11:8-13) wherein said resin is partially cured by radiation prior to addition of the thin metal film to the coating (Doi ELT 10:3-11:21). However, Doi is directed toward a method of transferring a thin metal film to a substrate in order to impart a metal tone appearance upon it, not a method of transferring an image to a substrate (Doi ELT 2:22-3:3; 18:3-4). Yamane '885 is directed to a method of image transfer, but it fails to disclose the use of a curable resin in the transfer layer, instead utilizing a non-curable surface treating agent (Yamane '885 patent col. 4 lines 4-16 and 40-46). Yamane JP, while being directed to a method of image transfer, fails to disclose the transfer of any coating layer whatsoever to the substrate, instead transferring only the ink image (Yamane JP English Language Abstract; see also discussion in Yamane '885 patent at col. 1 line 44 - col. 2 line 24). Wagner, which also relates to image transfer, utilizes a radiation curable resin that is necessarily left uncured prior to application of the ink image to the coating (Wagner patent col. 4 lines 23-27). Subsequent to ink application, the resin in Wagner is cured in such a manner as to fully cure the areas where the ink is absent and leave uncured the areas where the ink is present (Wagner patent col. 4 lines 27-30). No combination of the teachings of these cited references teaches the current invention. First, the radiation curable resin from Doi or Wagner would have no usefulness in the Yamane JP invention as that invention does not transfer any coating layer to the

substrate. Second, the use of the radiation curable resin from Doi or Wagner in the Yamane '885 invention will fail to create a workable invention, as the Yamane '885 invention relies upon a non-curable surface treating agent having certain tensile strength properties for the invention's operation (Yamane '885 patent col. 6 line 63 – col.7 line 6 and Figs. 1-4). Lastly, the use of an entirely partially cured resin from Doi in Wagner would again make the Wagner invention inoperable, as Wagner relies upon the cured state of the resin adjacent to the ink and the uncured state of the resin below the ink for the invention's operation (Wagner patent col. 4 lines 30-42; col. 3 lines 34-38; Figs. 1-6). Because combining the various coatings from these references would render inoperable these various image transfer inventions, these references actually teach away from their combination. Further, MPEP § 2143.01 Part V, citing *In re Gordon* (733 F.2d 900 (Fed. Cir. 1984)), states "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Here, utilizing Doi's curable composition in either Yamane '885 or Wagner would render those inventions unsatisfactory for their intended purpose of transferring ink images to substrates in the particular manners outlined in those patents, so there is no suggestion or motivation to make such a modification here. In addition, even if a workable invention could be created through combinations of these references, Applicants submit that combining these references to find obviousness is improper because these references fail to teach or even suggest their combination and no other motivation for their combination exists. For these reasons, Applicants submit that the rejections to these claims should be withdrawn and the claims allowed.

Claim 5

Claim 5, whose subject matter has been incorporated into new Claim 14, was rejected as being obvious and unpatentable over Doi (JP 01-202492) in view of Yamane JP (JP 63-128987), Wagner (U.S. Patent No. 6,486,903), and Oshima (U.S. Patent No. 5,427,997) and over Yamane '885 (U.S. Patent No. 5,320,885) in view of Doi (JP 01-202492), Wagner (U.S. Patent No. 6,486,903), and Oshima (U.S. Patent No. 5,427,997). Applicants respectfully submit that such combinations of references

fail to render the current invention obvious and request that the rejections be withdrawn and the claim allowed.

Claim 14 discloses the transparent coating layer of the current invention containing 1-20% of an inorganic filler relative to the resin solids content. Doi, Yamane JP, Yamane '885, and Wagner all fail to disclose the use of such an inorganic filler in an amount relative to the resin solids content. However, Examiner found this claimed subject matter to be obvious in further view of Oshima, stating that "it would have been obvious...to utilize an inorganic filler in the radiation-curable transparent protective resin of Doi motivated by the fact that Oshima, also drawn to methods for the protection of images...discloses that the inclusion of an inorganic filler at about 10 wt% of the total resin solids content...enables sufficient 'film-cutting' while maintaining the transparency of the protective film" (April 28, 2006 Office Action 4:1-7).

Applicants submit that the combinations of Doi, Yamane JP, Yamane '885, and Wagner with Oshima fail to render the current invention obvious because there is a lack of motivation to combine these references. While Oshima does disclose the use of inorganic filler in an amount claimed in the current application, the inorganic filler in Oshima is used for a purpose that is irrelevant to all of the other cited references, and the current invention as well. Oshima states that the transparent resins disclosed in that patent "excel in transparency but tend to form films so relatively tough that they cannot be well cut at the time of transfer" (Oshima patent col. 7 lines 50-53), and that mixing in wax with these resins improves the resins "in terms of the 'film-cutting' at the time of transfer" (Oshima patent col. 7 lines 55-58). Film-cutting, as is necessary in Oshima, is not a major issue in the other cited references or the current invention, however. Film-cutting is necessary only where the coating must be cut such that not all of the available coating remains on the substrate. Doi involves the entire coating remaining on the substrate; cutting of the Doi coating is discussed nowhere in that reference. Yamane '885 and Wagner operate in such a manner that the coating by definition cuts itself where it is not to remain on the substrate, so cutting of the film is not necessary in those inventions, either (Yamane '885 patent col. 3 lines 34-41 and Figs. 1-4; Wagner patent col. 4 lines 34-39 and Figs. 1-6). Yamane JP transfers no coating layer whatsoever, only ink, so there is no coating layer that could require cutting (Yamane English

Language Abstract; Yamane '885 patent col. 1 line 44 - col. 2 line 24). Thus, the use of inorganic fillers in Oshima has no usefulness in the other cited reference inventions. In addition, the current invention suggests the use of inorganic fillers for reasons quite disparate from the "film-cutting" reason put forth in Oshima. The current invention states that the use of inorganic fillers is desirable for imaging purposes, such as enhanced image quality or enhanced image acceptance by the coating (9:7-15), which is quite different than Oshima's "film-cutting" purpose. There would therefore be no motivation to combine Oshima with Doi, Yamane JP, Yamane '885, or Wagner to create a resin layer in those inventions that includes an inorganic filler as is used in the current invention. MPEP § 2143.01 Part III, citing *In re Mills* (916 F.2d 680 (Fed. Cir. 1990)), states "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Further, MPEP § 2143.01 Part I, quoting *In re Rouffet* (149 F.3d 1350, 1357 (Fed. Cir. 1998)), states that "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of the person of ordinary skill in the art" but "the level of skill in the art cannot be relied upon to provide the suggestion to combine." The inorganic fillers in Oshima are being used to solve a very different problem than in the current invention. Further, the problem solved by the inorganic fillers in Oshima has no usefulness in the other cited references. Thus, the nature of the problem being solved cannot be relied upon to provide the motivation for combining these references. The prior art references here also fail to teach or even suggest that a combination of these inventions would be desirable, so that also cannot provide the necessary motivation to combine. Thus, none of the sources for motivation to combine exist here, so such a combination is improper. Because of this, Applicants submit that these references fail to render the current invention obvious and therefore respectfully request that the rejections as to the subject matter of Claim 14 be withdrawn and the claim allowed.

Claims 6 and 7

Claims 6 and 7, whose subject matters have been incorporated into new Claims 15 and 16, respectively, were rejected as being obvious and unpatentable over Doi (JP 01-202492) in view of Yamane JP (JP 63-128987), Wagner (U.S.

Patent No. 6,486,903), Oshima (U.S. Patent No. 5,427,997), and Shvartsman (U.S. Patent No. 6,245,382) and over Yamane '885 (U.S. Patent No. 5,320,885) in view of Doi (JP 01-202492), Wagner (U.S. Patent No. 6,486,903), Oshima (U.S. Patent No. 5,427,997), and Shvartsman (U.S. Patent No. 6,245,382). Applicants respectfully submit that such combinations of references fail to render the current invention obvious and request that the rejections be withdrawn and the claims allowed.

As an initial matter, neither the previously cited references nor the Shvartsman reference teach nor even suggest that a combination would be desirable or even possible, showing a basic lack of obviousness in combining these references. MPEP § 2143.01 Part III, citing *In re Mills* (916 F.2d 680 (Fed. Cir. 1990)), states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As there is no such suggestion in the cited references here and no other motivation to combine these references, Applicants contend that these references should not be combined to arrive at a finding of obviousness. However, Applicants further submit that, even if combined, these references fail to render the current invention obvious. Shvartsman is directed to a method of preparing a protective film for a data carrying device, such as a credit card (Shvartsman patent 2:14-17). This invention states that multiple protective layers could be used in combination to increase the protective effects of the coating layer (Shvartsman patent 2:26-29). However, this idea of using multiple protective layers from Shvartsman combined with the other cited references still fails to teach the current invention. As stated above, the other cited references fail to teach the current invention in single-coating-layer form, so addition of Shvartsman does nothing to render the current invention obvious. In addition, the Shvartsman invention is not at all related to Applicants' invention, which is directed to a method of transferring an image on a curable transparent coating to a substrate and then subsequently fully curing the coating. Shvartsman does not have an image to transfer, but merely forms a protective film. Thus, Applicants submit that the cited references fail to render the current invention obvious and request that these rejections be withdrawn and the claims allowed.

Claim 10

Claim 10 was rejected as being obvious and unpatentable over Doi (JP 01-202492) in view of Yamane JP (JP 63-128987), Wagner (U.S. Patent No. 6,486,903), and Bruns (U.S. Patent No. 4,737,322) and over Yamane '885 (U.S. Patent No. 5,320,885) in view of Doi (JP 01-202492), Wagner (U.S. Patent No. 6,486,903), and Bruns (U.S. Patent No. 4,737,322). Applicants respectfully submit that such combinations of references fail to render the current invention obvious and request that the rejections be withdrawn and the claim allowed.

As an initial matter, neither the previously cited references nor the Bruns reference teach nor even suggest that they can be combined, showing a basic lack of obviousness in combining these references. MPEP § 2143.01 Part III, citing *In re Mills* (916 F.2d 680 (Fed. Cir. 1990)), states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As there is no such suggestion in the cited references here and no other motivation to combine these references, Applicants contend that these two references should not be combined to arrive at a finding of obviousness. Further, as was argued in the previous Response to Office Action (March 16, 2006 Response page 9, paragraph 1; page 12, paragraph 4), Bruns is completely unrelated to Applicants' invention, being directed to improved intraocular lens structures for surgical placement in the eye (Bruns patent 3:54-57). Though Bruns discloses the use of thermal curing of the optical implants (Bruns patent 5:22-24), because of the vastly disparate fields of invention, Applicants contend use of this reference for a finding of obviousness is improper. MPEP § 2141.01(a), quoting *In re Oetiker* (977 F.2d 1443, 1446 (Fed. Cir. 1992)) and *Wang Laboratories v. Toshiba Corp.* (993 F.2d 858 (Fed. Cir. 1993)), states that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned" with "reasonably pertinent" defined as being a reference which "even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Here, the cited reference, Bruns, is unquestionably not in the current applicant's "field of endeavor," as Bruns

relates to surgical eye implants and the current invention relates to a method of transferring images to substrates. Applicants also contend that the Bruns reference is not “reasonably pertinent to the particular problem with which the inventor was concerned.” The Bruns invention deals with a novel type of surgical eye implant, which certainly involves different desired properties than are desirable for protective coating layers for images. While Examiner points out that both require optical clarity, that is likely the only common desirable property in a good protective image layer and a good eye implant. The level of toughness, rigidity, and resistance to various compounds desired in protective layers for images and eye implants almost certainly differ greatly. Because of these vast differences, the Bruns invention is not one which “would have commended itself to [the current] inventor’s attention.” Thus, because Bruns is neither in the “field of endeavor” of the current invention nor would it have “commended itself to an inventor’s attention in considering his problem,” it was an improper reference to use as a basis for rejection of the current invention. For these reasons, Applicants submit that the cited references fail to render the current invention obvious and therefore respectfully request that the rejections be withdrawn and the claim allowed.

In addition, Claim 10 states that curing of the protective coating in the current invention proceeds by way of thermal curing while Doi specifically states that the coating layer is curable by radiation only, be it electron beam or UV radiation (Doi ELT 11:4-22). Nowhere in the Doi patent is it taught or even suggested that thermal curing is possible or desirable. Further, Doi impliedly teaches away from the use of thermal curing in the following manner. The problem that the Doi invention was intended to solve is that prior art methods for transferring a thin metal layer to a substrate would frequently result in a dulling of the metal luster of the thin metal layer during the transfer process (Doi ELT 4:1-5). This dulling was due to excessive heating of the coating layer during the transfer process (Doi ELT 4:1-5). Thus, heating of the protective layer in Doi in order to cure that layer would likely cause the very problem that the invention was intended to solve. Therefore, the use of thermal curing of the protective layer would seem to be specifically disclaimed by the Doi invention. In addition, MPEP § 2143.01 Part V, citing *In re Gordon* (733 F.2d 900 (Fed. Cir. 1984)), states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no

suggestion or motivation to make the proposed modification." Here, because excessive heating of the metal layer during thermal curing will likely cause the very problem that the invention was designed to correct, modification of Doi to use thermal curing, as is done in Bruns, would likely render the Doi invention unsatisfactory for its intended purpose. Thus, Applicants submit that there is no suggestion or motivation for the proposed modification here, and consequently no showing of obviousness. For all of these reasons Applicants contend that the references cited fail to render the current invention obvious and respectfully submit that the rejections as to this claim should be withdrawn and the claim allowed.

SUMMARY

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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